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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,782	01/29/2001	Daniel P. Kelly	A00219US (98361.3)	8325

7590 10/22/2002

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EXAMINER

LEE, EDMUND H

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 10/22/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/771,782

Applicant(s)

KELLY, DANIEL P.

Examiner

EDMUND H LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-45 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) 44 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-43 and 47-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 37-43 and 47-49, drawn to a method of making necklaces, classified in class 264, subclass 251.
- II. Claim 44, drawn to a necklace, classified in class 63, subclass 3.
- III. Claim 45, drawn to an apparatus, classified in class 425, subclass 116.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as a process for making a pull-string for lamps.

3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as fusion bonding beads onto a string.

4. Inventions III and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the

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apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product such as pull-strings for lamps.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation between Ex. Jackson and S. Nehrbass on 8/14/02 a provisional election was made without oral traverse to prosecute the invention of group I, claims 37-43 and 47-49. Affirmation of this election must be made by applicant in replying to this Office action. Claims 44-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 37-43 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bateholts (USPN 1958841) in view of American Fund Raisers (promotional information on the Internet). In regard to claim 37, Bateholts teaches the basic claimed process including a method of making a necklace (pg 1, lns 1-10; figs 1-4); providing a mold of beads for a necklace wherein the beads can be spherical or

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cylindrical (figs 1-4); placing a string or other line or cord in the mold (figs 1-4); supplying plastic to the mold (figs 1-4); removing from the mold a necklace formed of beads directly molded onto the string or line or cord. However, Bateholts does not teach beads having a sport projectile shape. American Fund Raisers teaches necklaces having sport shaped beads. Bateholts and American Fund Raisers are combinable because they are analogous with respect to beaded necklaces. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made make the sports shaped beaded necklace of American Fund Raisers by the process of Bateholts in order to efficiently mold the necklaces. In regard to claims 38-43 and 47-49, Bateholts does not teach adding a sports projectile bead larger than the other beads; molding football beads; molding baseball beads; molding soccer beads; molding hockey beads; attaching one or more pendants to the necklace wherein the pendant is larger than the projectile shaped beads; attaching a two colored pendant to the necklace; using a sport logo shape pendant. American Fund Raisers teaches using football beads; using baseball beads; using soccer beads; using hockey beads; providing/attaching one or more pendants to the necklace wherein the pendant is larger than the projectile shaped beads; providing/attaching a two colored pendant to the necklace--as a note, the website flashes various two colored pendants adjacent sports beads; using a sport logo shape pendant. Since Bateholts and American Fund Raisers are combinable for the above reasons, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold any of the necklaces of American Fund Raisers by the process of Bateholts in order to efficiently mold them. In

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regard to adding a sports projectile bead larger than the other beads, such is well-known in the necklace art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a sports projectile bead larger than the other beads to the necklace of Bateholts (modified) in order to broaden the appeal of the necklace.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. MardiGras Outlet (promotional information) teaches a baseball bead larger than adjacent beads on a beaded necklace. Ametraco.com (promotional information) teaches beaded necklaces having sports beads thereon. Plebanek (USPN 2366932) teach molding beaded cords.

10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Edmund Lee whose telephone number is (703) 305-4019. The examiner can normally be reached on Monday-Wednesday and Friday from 8:00 AM to 4:00 PM. The fax number for Examiner Edmund Lee is (703) 872-9615. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached on (703) 308-3829. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

EHL

October 1, 2002



Edmund Lee 10/1/02

Patent Examiner, AU 1732